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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/815,882

03/23/2001

Paul O. Detwiler

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EXAMINER

FRECH, KARL D

ART UNIT

PAPER NUMBER

2887

MAIL DATE

DELIVERY MODE

12/23/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/815,882	Applicant(s) DETWILER ET AL.	
	Examiner Karl D. Frech	Art Unit 2887	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-32,36-44,46-62 and 93-102 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-32,36-44,46-62,93-102 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
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| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Applicant's response filed 5/8/08 has been entered. Claims 22-32,36-44,46-102 are pending.
2. The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414. The error stated is not specific enough. MPEP 1414 (II)(C) states "(a)ny error in the claims must be identified by reference to the specific claims(s) **and the specific claim language** wherein lies the error". It further states that "(a) statement of "failure to include a claim directed..." and then presenting a newly added claim would not be considered a sufficient "error" statement since applicant has not pointed out what the other claims lacked that the newly added claim has, or visa-versa. Applicant has failed to identify the specific claims and the specific claim language wherein lies the error. Applicant has filed two declarations with different errors. The original declaration by the assignee was filed on 3/23/01 and another declaration from the assignee filed 5/8/08. If the error in either declaration was specific enough MPEP (ii)(C), it would be acceptable. However, neither error is specific enough. The error cited in the original declaration filed on 3/23/01 is closer to being acceptable error but it is still not specific enough. The applicant lost claims 1-21 and 33-35 in an interference with us SN 09/078,196 (now US Patent 6,568,598). Basically, the error is that applicant claimed more than he had a right to claim (i.e. claims 1-21 & 33-35) as decided in Interference No. 104,631.
3. Claims 22-32,36-44,46-62,93-102 are rejected as being based upon a defective reissue oath/declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the oath/declaration is set forth in the discussion above in this Office action.

4. Claims 36-44,46-62,93-102 are rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period. A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would not have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

5. The application was filed more than 2 years after the issue date of the patent. Thus, it cannot broaden any of the original patent claims in any way (see 35 USC 251 and MPEP section 1412.03(IV)). As stated in MPEP 1412.03(I), "a claim of a reissue application enlarges the scope of the claims of the patent if it is broader in at least one respect, even though it may be narrower in other respects." The same section also states "a claim would be considered a broadening claim if the patent owner would be able to sue any party for infringement who previously could not have been sued for infringement." In the instant application claim 22 requires a primary, secondary, and tertiary set of pattern mirrors. Added claims 36,37,38,40,44,56,59 and 60 and their dependents only require a primary and secondary set of pattern mirrors, but no tertiary set of pattern mirrors and are therefore broadening claims in at least this respect. Further, independent claims 22,24,28 require that the mirrors be set at "oblique" angles. However, all of the claims 36-44,46-62,102 are silent as to the "oblique" angles and are therefore broadening in at least this respect.

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6. It is noted that Vectra Fitness Inc. v. TNWK Corp., USPQ2d 1144 (Fed. Cir. 1998), although it dealt with a statutory disclaimer filed before reissue, clearly stated "(a) statutory disclaimer under 35 USC Section 253 has the effect of canceling the claims from the patent and the patent is viewed as though the disclaimed claims had never existed in the patent." It has been held to treat a statutory disclaimer as a retroactive document, no matter when it was filed and accepted. In the instant case, there was a statutory disclaimer of claims 1-21 and 33-35 in U.S. Patent 5,684,389 (see the papers dated 4/21/05 in parent application S.N. 08/550,150). Accordingly, concerning the question of broadening, the scope of the newly added claims must only be compared to claims 22-32 of the current application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl D. Frech whose email address is karl.frech@uspto.gov. If attempts to reach the examiner by email are unsuccessful, the examiner's telephone number is (571) 272-2390. The examiner can normally be reached on maxi-flex.


If ALL attempts to reach the examiner are unsuccessful, the examiner's supervisor, Steven Paik can be reached on (571) 272-2404. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Karl D Frech/
Primary Examiner, Art Unit 2887

7.

Application Number 	Application/Control No.	Applicant(s)/Patent under Reexamination	
	09/815,882	DETWILER ET AL.	
	Examiner	Art Unit	
	Karl D. Frech	2887	